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IN THE

Supreme Court of the United States

OCTOBER TERM, 1961.

No. 917

EDWARD A. ZEGERS, d/b/a PRECISION WEATHERSTRIP CO.,

Petitioner,

v.

ZEGERS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered in the above-entitled case on February 27, 1962.

CITATIONS TO OPINIONS BELOW.

The opinion of the District Court (App. 381)[1] is unreported. The order of the District Court (BD—97)[2] deny-

[1] "App." citations refer to the appendix record on appeal in the Court of Appeals, nine copies of which are filed herewith.

[2] "BD" citations refer to the "Book of Documents and Exhibits Under Rule 18" constituting part of the record in the Court of Appeals, a certified copy of which is filed herewith.

ing petitioner's motion for a partial new trial is unreported, and is printed in Appendix C hereto, *infra*, page 13a. The opinion of the Circuit Court of Appeals is printed in Appendix B hereto, *infra*, page 5a, and is reported at F. 2d , 132 U. S. P. Q. 570 (CA 7—1962).

JURISDICTION

The judgment of the Circuit Court of Appeals was entered on February 27, 1962. Rehearing was denied on March 30, 1962. The jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254(1).

QUESTIONS PRESENTED

1. Whether the Patent Act of July 19, 1952 (Title 35 United States Code) has overruled earlier decisions of this Court to such an extent that misuse by a plaintiff of its patent in suit, commencing prior to the bringing of a civil action for patent infringement and continuing until after the trial of the civil action, no longer constitutes a bar to prosecution of the action for patent infringement.

2. Whether the Patent Act of July 19, 1952 (Title 35 United States Code) has so changed the law that a patent, which issued on an application knowingly filed by the assignee thereof in the name of "X", as the inventor, when "Y" was the person who conceived the alleged invention, disclosed it to "X", and consulted with and worked with "X" throughout the reduction of the alleged invention to practice, should not now be held invalid because it issued in the name of "X" as sole inventor.

STATUTES INVOLVED

The statutory provisions involved, Section 2 of Title 15 U. S. C., and Sections 102, 111, 115, 116, 256, and 271 of Title 35 U. S. C., are printed in Appendix A hereof, *infra*, page 1a.

STATEMENT

On July 30, 1959, respondent, Zegers, Inc., filed a complaint (App. 3) alleging infringement of William H. Zegers patent No. 2,869,184 (App. 397) by petitioner, Edward A. Zegers. The jurisdiction of the District Court was invoked by respondent under 28 U. S. C. 1338(a), because the case is one arising under the patent laws. Petitioner filed an answer and counterclaim (App. 5) alleging, among other things, misuse of the patent by respondent. At the close of the trial the District Court, on respondent's motion, dismissed the counterclaim as to misuse.

On December 12, 1960 the District Court handed down findings of fact and conclusions of law (App. 381) finding said patent valid and infringed. Judgment was entered on December 12, 1960, and petitioner filed his notice of appeal on January 10, 1961. The appeal was timely docketed on April 3, 1961, and, on June 7, 1961, on petitioner's motion, the Court of Appeals entered an order remanding the case to the District Court for the purpose of presenting a motion for a partial new trial based on newly discovered evidence. On August 25, 1961, the District Court entered an order (*infra*, page 13a) denying petitioner's motion for a partial new trial. On February 27, 1962, the Court of Appeals handed down an opinion (*infra*, page 5a), affirming the District Court's opinion of December 12, 1960 and its order of August 25, 1961. On March 30, 1962, petitioner's petition for rehearing was denied.

Patent No. 2,869,184, in suit, entitled "Clip for Combination Weatherstrip and Sash Balance", issued January 20, 1959 to respondent, Zegers, Inc., as assignee of the patentee, William H. Zegers, on an application filed April 3, 1957. It discloses a complete window structure, including a window frame, window sashes slidably mounted in the frame, and weatherstrip units mounted between the sashes and the frame. It also discloses clips for removably mounting the weatherstripping in the window frame.

There is no dispute that *everything disclosed in the patent in suit is old and well known in the art*, except the aforementioned clip. Respondent previously, without success, had even tried to patent exactly the same window structure without the clip. Also, there is no dispute that the weatherstrip units shown in the patent in suit are old and well known in the art, and are staple articles of commerce suitable for substantial non-infringing use.

On June 16, 1959, prior to the filing of the complaint herein, the respondent, through its attorneys, by letter (App. 372) charged the petitioner with infringing the patent in suit by selling its unpatented, and unpatentable "Seal-Eaz" and "Alcoté" weatherstripping, *per se*. At this same time, and continuing until at least May 18, 1961, several months after the trial of this action, the respondent was, admittedly, also falsely marking notice of the patent in suit on cartons in which it sold unpatented and unpatentable weatherstripping without clips, and even various types of weatherstripping and other window structures, which were not even adapted to be used with clips.

The aforementioned letter of June 16, 1961 was placed in evidence by the petitioner at the trial. At the close of the trial the Court, on respondent's motion, dismissed the petitioner's counterclaim of misuse.

The evidence with respect to the aforementioned false

marking did not come to petitioner's attention until after the appeal in this civil action had been docketed in the Court of Appeals. He thereupon successfully petitioned the Court of Appeals for an order remanding the case to the Trial Court for the purpose of presenting a motion for a partial new trial. On remand, the District Court denied petitioner's motion for a partial new trial. In accordance with the Court of Appeals order of remand, the record in the District Court on the motion for a partial new trial was certified to the Court of Appeals for inclusion in the record on appeal.

Petitioner's contention was that this conduct of the respondent was an unlawful attempt to expand the monopoly of its patent, and constituted a misuse of the patent in suit, which, under the decisions of this Court, barred it from prosecuting the present action for patent infringement. The Court of Appeals overruled this contention.

With respect to who was the inventor of the alleged invention of the patent in suit, the undisputed facts show that:

1. Raymond Zegers, a salesman for, and previously Manager of Installation for respondent, conceived the idea of removably clipping weatherstrip units in a window frame with some "structure that would over-lap the edge of the weatherstrip" (App. 172), so that the weatherstrip could be flexed into and out of clipped position on the window frame, instead of nailing it in place.
2. Upon his return to respondent's office he disclosed the idea to William H. Zegers, vice president of the respondent and son of Henry Zegers, then president of respondent.
3. William Zegers liked the idea (App. 173), and immediately accompanied Raymond Zegers to a shop

in respondent's plant, where, working together, they experimented with the idea of removably clipping the weatherstrip to the window frame.

4. At first they used nails and half-headed nails as clips, positioning the nails in the window frame so that the heads protruded, the weatherstrip being flexed into and out of underlying position relative to the nail heads. The nails were successful as clips (App. 216-217), and showed them that the weatherstrip could be flexed into and out of a clip which over-lapped its edge portion.

5. However, the nails were a little too thick and a little too high, and William Zegers then fashioned, from a piece of sheet metal, a thinner clip having one hooked end, which overlapped one edge of the weatherstrip in the same manner as the thicker nail heads. This form of the clip also worked, and William Zegers then made the clip with two hooked ends instead of one.

6. The entire experimenting took only a few hours of a single day after the original disclosure of the conception by Raymond Zegers to William Zegers, and they continuously discussed the matter between them and worked together throughout the development work (App. 181, 215, 217).

7. When the application for the patent in suit was first prepared, it was prepared in the name of Raymond Zegers, alone, as sole inventor. It was shown to Raymond Zegers in that form by Thomas P. Koebel, General Manager of the respondent (App. 166, 181). Thereafter, even though patent counsel warned Mr. Koebel that the application had to be filed in the name of the true inventor, he had the application re-prepared in the name of William

Zegers alone. He did this without ever checking with Raymond Zegers and, in fact, without even telling him that the change was being made (App. 168). Raymond Zegers was surprised when the patent issued in the name of William Zegers as inventor (App. 181).

It was the contention of the petitioner that the application was knowingly filed in the name of William Zegers, as sole inventor, when the respondent knew that it should have been filed in the names of both Raymond Zegers and William Zegers as joint inventors, and, therefore, that the patent which issued thereon is invalid under the provisions of Sections 102, 111, 115, 116, and 256, Title 35 U. S. C. The District Court overruled this contention, and the Court of Appeals affirmed the District Court.

REASONS FOR GRANTING THE WRIT.

1. Misuse of the Patent.

The decision of the Court below is directly contrary to (a) the decision of this Court in *Leitch Manufacturing Co. v. Barber Co., Inc.*; 302 U. S. 458, 463, 82 L. Ed. 371, 374, wherein the Court stated (page 463):

> "* * * *every* use of a patent as a means of obtaining a limited monopoly of unpatented material is prohibited. It applies whether the patent be for a machine, a product, or a process. It applies *whatever* the nature of the device by which the owner of the patent *seeks to effect such unauthorized extension of the monopoly*".

(b) the decision of this Court in *U. S. Gypsum Co. v. National Gypsum Co.*, 352 U. S. 457, 465, 1 L. Ed. 2d 465, wherein the Court stated (page 465):

* Emphasis added throughout this petition unless otherwise indicated.

> "It is now, of course, familiar law that *the courts will not aid a patent owner who has misused his patents* to recover any of their emoluments accruing during the period of misuse or thereafter until the effects of such misuse have been dissipated, or 'purged' as the conventional saying goes." (Citing cases) "*The rule is an extension of the equitable doctrine of 'unclean hands' to the patent field.*"; and

(c) the decision of this Court in *Mercoid Corp.* v. *Mid-Continent Investment Co. et al.*, 320 U. S. 661, 666, 669, 88 L. Ed. 376, 381, 383, (which this Court cited with approval in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 365 U. S. 336, 5 L. ed. 2d 592) wherein the Court stated (pages 666 and 669):

> "The *method* by which the monopoly is sought to be extended is *immaterial*".
>
> * * * in *whatever posture* the issue may be tendered *courts of equity will withhold relief* where the patentee and those claiming under him are using the patent privilege *contrary to the public interest.*"

Section 2 of the Sherman Act (15 USC 2) *infra*, page 1a, provides:

> "*Every* person who shall monopolize, or *attempt* to monopolize * * * any part of the trade or commerce among the several States * * * shall be deemed guilty * * * *"

There can be no question but what respondent has attempted to extend the monopoly of its patent. By its letter of June 16, 1959, it attempted to use the patent to scare its competitor, the petitioner, into discontinuing the sale of his unpatented and unpatentable "Seal-Eaz" and "Alcote" weatherstrip. If petitioner had been made of more timid stuff, this case would never have come to trial. He would have been intimidated by this unlawful threat of respondent into abandoning the manufacture and sale of

his weatherstrip units, which the respondent *knew* were not only unpatented but unpatentable (the respondent having previously unsuccessfully tried to patent those units).

Obviously, the letter constituted a misuse of the patent. It was an unlawful attempt to expand the monopoly of the patent to cover unpatented weatherstripping, *per se*. It can not even be excused as a possible accidental wrongful charge of infringement made by some layman officer, or employee of respondent, who possibly might not know the legitimate scope of a patent. It was sent to petitioner by respondent's patent counsel.

At the same time that respondent was attempting to wrongfully intimidate petitioner, personally, into abandoning manufacture and sale of his unpatented and unpatentable weatherstrip units, it was also misusing the patent against the public generally by falsely marking notice of the patent, in suit, on containers in which it admittedly sold weatherstrip units and other window equipment, which did not come within the monopoly of the patent in suit. Said false marking continued from before the complaint was filed in this case until long after the trial.

In its opinion, the Court of Appeals recognized that the plaintiff had in fact charged the defendant with infringement of the patent in suit by sale of its unpatented and unpatentable weatherstripping, *per se*. In that connection the Court of Appeals stated (*infra*, pages 10a-11a):

> "* * * Defendant relied principally on a letter sent by plaintiff to defendant which charged that defendant was infringing plaintiff's patent by sales of his 'weatherstrip * * * Seal-Eaz' and his 'modified weatherstrip * * * Alcote.'"

However, without giving any reason for so doing, the Court of Appeals overruled the defendant's defense of unclean hands and misuse.

Immediately following the above set forth statement, the Court of Appeals made the following irrelevant remark:

> "Defendant's own letters and accompanying literature describing the accused devices show that his 'Seal-Eaz' and 'Alcote' were being promoted for sale with clips."

Said remark, has no bearing, whatever, on respondent's misuse of its patent. It is in the nature of a non-sequitur insofar as the immediately preceding statement is concerned. In the first place, the record shows that only a small fraction of the petitioner's total weatherstrip sales were made for use with clips, 82 to 84 percent of petitioner's weatherstrip being sold *without* clips. However, even if most of petitioner's weatherstrip had been sold with clips, such circumstance would still not give respondent any right to charge the unpatented and unpatentable weatherstrip, *per se*, as an infringement.

With respect to the admitted false marking, which continued from some time in the year 1959 until at least May 18, 1961, the Court of Appeals ruled that:

> "* * * the District Judge found that the plaintiff had shipped some if its products which were not covered by the patent in suit, in cartons bearing the patent number. He determined that this was the result of error in selection of cartons in plaintiff's shipping department; that, on notification of the errors, plaintiff took immediate steps to ensure that the patent number was removed from all cartons leaving its factory; and that no intent to deceive or resulting damage was shown. Under these circumstances we cannot rule that denial of defendant's motion for partial new trial constituted an abuse of the District Court's discretion * * *."

All of these conclusions relative to the manner in which the false marking occurred *are based solely on the uncorrobor-*

ated, self-serving affidavit (BD 89) *of Thomas P. Koebel, Vice-President and General Manager of the respondent,* which, of course, is not evidence. The *undisputed* facts show that at least one person was *misled* by the false marking (BD 95) and that the false marking was *extensive*.

Furthermore, the defense of unclean hands does not require a showing of damage, it is an ordinance which is self-imposed by the Courts (*Precision Instrument Co.* v. *Automatic Co.*, 324 U. S. 806, 89 L. Ed. 1381).

Here, there was a clear misuse. The respondent should have been barred from prosecuting this civil action because of such misuse, under the doctrine of unclean hands. To hold otherwise, is directly contrary to the decisions of this Court. The 1952 Patent Act has not changed the law with respect to this matter. An authoritative ruling on the question by this Court is plainly in the public interest, and is required to insure an orderly administration of justice, and to lay at rest, for all time, the question of whether the 1952 Patent Act has so changed the law that an attempt by a patent owner to expand the monopoly of its patent to cover what he *knows* are unpatented and unpatentable staple articles of commerce suitable for substantial non infringing use is no longer a misuse of the patent.

2. Joint Inventorship.

The United States Court of Appeals for the Seventh Circuit has erroneously decided an important question of federal law relating to patents under the 1952 Patent Act, which has not been, but should be settled by this Court to effect the orderly administration of justice. The question presented herein (question No. 2, p. 2, *supra*) is an important public federal question relating to a basic statutory limitation controlling the validity of patents. This question, in the public interest, and in the interest

of the orderly determination of patent cases in the federal courts, should be settled forthwith by an immediate authoritative ruling of this Court.

Section 102, Title 35 USC (*infra*, page 1a) provides:

"A person shall be entitled to a patent unless—

• • •

"(f) he did not himself invent the subject matter sought to be patented. • • •"

Section 111, Title 35 USC (*infra*, page 1a) requires that the application for patent be made by the inventor, and Sec. 115, Title 35 USC (*infra*, page 1a) requires the applicant to make oath that he believes himself to be the inventor of that for which he solicits a patent.

Section 116, Title 35 USC (*infra*, page 2a) provides that:

"When an invention is made by two or more persons jointly they shall apply for patent jointly and each sign the application and make the required oath • • •"

What constitutes a joint invention is well summarized in "Robinson on Patents," Vol. 1, pages 568-569, wherein it is stated:

"• • • In short, *wherever, before the entire conception* of the invention by one inventor, *another* meets him and *by his consent unites with him* in exercising inventive skill upon the development and perfecting of the conception, *the product of their endeavour is a joint invention.*

• • • • • •

"The *exact part* which each performs is of *no consequence* • • •. It is enough if the experiment which finally succeeds—the one which demonstrates the practicability of accomplishing the end in view, and indicates the means by which it is attainable—*has been conducted under their joint supervision, and in accordance with ideas and theories to which both have contributed.*"

The Court of Appeals decision in this case is contrary to the well established rule of law set forth immediately above as to what constitutes a joint invention. It is also directly contrary to the decisions of Courts of Appeal in other Circuits in the cases of *Smart* v. *Wright*, (CA-8), 227 Fed. 84, 87; *McKinnon Chain Co.* v. *American Chain Co.* (CA-3), 268 Fed. 353, 360; *Bourne* v. *Jones* (D. C. S. D. Fla.), 114 F. Supp. 413, 418, 419 (affirmed, CA 5, 207 F. 2d 173); and *Schreckhise* v. *Ritchi* (CA-4), 160 F. 2d 593, 595.

Here, Raymond Zegers conceived the idea of removably clipping the weatherstrip unit, in a window frame by the use of a "structure that would overlap the edge of the weatherstrip" (App. 172). He disclosed the conception, including the overlapping feature to William Zegers. The two of them worked on the alleged invention together, discussing and consulting together throughout the reduction of the invention to practice, in its final form. These are the basic facts. There is no dispute concerning them.

There being no significant dispute as to the basic facts pertinent to the lower Court's decision, but only as to the conclusion which the lower Court drew therefrom, this Court may reverse the judgment below without even considering the question of whether findings of fact are clearly erroneous under Rule 52(a) of the Federal Rules of Civil Procedure (*U. S. v. Du Pont & Nemours Co.*, 353 U. S. 586, 598, 1 L. ed. 2d 1057).

The conclusion of the Court of Appeals that this was not a joint invention is an erroneous conclusion which is contrary to the established test of joint inventions.

Even the other conclusions, which the Court of Appeals set forth as the basis for its conclusion that there was no joint invention are clearly contrary to the aforementioned basic facts on which there is no dispute. Those conclusions that are contrary to fact were stated by the court as follows (*infra*, page 10a):

"The testimony indicates . . . that Raymond Zegers had urged the need for ready removability and had suggested one method which involved use of nails, but *which had proved unsuccessful;* that William H. Zegers had *independently conceived* the device shown in the patent application. Raymond Zegers himself was one of the witnesses *who testified to that effect at the trial.*"

The undisputed facts show that:

(1) The method suggested by Raymond Zegers had *not* "proved unsuccessful." The method he suggested was a "structure that would over lap the edge of the weatherstrip." (An apt description of the clip of the patent in suit). Furthermore, every single one of the particular forms of the suggested structure worked. Both Raymond Zegers (App. 176) and William Zegers (App. 216-217) testified that even the nails were successful as clips and showed that the weatherstrips could be flexed into and out of the clips.

(2) William Zegers had *not* "independently conceived the invention." He would not even have thought of it if Raymond Zegers had not disclosed the idea of removably mounting the weatherstrip in the window frames by means of clips which overlapped the edges of the weatherstrip. The two of them worked together *continuously* during the development of the idea into its final form, in accordance with ideas which *both* contributed.

(3) Raymond Zegers did *not* testify "to that effect at the trial." He (and William Zegers) testified in accordance with the "basic facts" set forth above.

Hence, if it were necessary to do so, this Court would be perfectly justified in finding that the conclusions of the Court of Appeals were "*clearly erroneous.*"

Prior to the enactment of the new patent statute in

1952, if a patent issued in the name of a single inventor, when it should have issued in the names of two or more joint inventors, the patent was automatically invalid, even if its proper issuance had been caused by inadvertence, accident, or mistake.

In the 1952 patent statute, Congress provided limited relief from this stringent rule. In one section (Sec. 116, Title 35 USC, *infra*, page 2a) it provided for adding a joint inventor to an application, under certain circumstances. The pertinent portion of this section reads as follows:

> "Whenever a person is joined in an application for patent as joint inventor through *error*, or a joint inventor is not included in an application through *error*, and such *error* arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes."

In another section (Sec. 256, Title 35 USC, *infra*, page 3a) Congress provided for adding a joint inventor to an issued patent, under certain circumstances. The pertinent portion of this section reads as follows:

> "Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by *error* and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.
>
> "The misjoinder or nonjoinder of joint inventors shall not invalidate a patent if *such* error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly."

The Senate report which accompanied this bill (Sen. Rep. No. 1979, June 27, 1952), which repeats in substance House Report No. 1923, May 12, 1952, states with respect to this section (Sec. 256) of the statute as follows (2 U. S. Code Congressional and Administrative News 2401):

> "Very often two or three people make an invention together. They *must* apply as joint inventors. If they make a mistake in determining who are the true inventors, they do so at their peril. This provision permits a *bona fide* mistake in joining a person as inventor or in failing to join a person as an inventor to be corrected."

Thus, it will be seen that the Congressional intent, when it provided in Section 256 for adding to a patent a joint inventor who had been "omitted by *error*," was that it applied only to a situation where the person had not been joined through a *bona fide* mistake—not a situation where the omitted inventor's name was deliberately omitted from the application. There was no *bona fide* mistake in the present case. In this case Raymond V. Zegers' name was deliberately omitted from the application. In fact, it was deliberately *removed* therefrom.

Insofar as petitioner's counsel have been able to find there is only one reported court decision interpreting Section 256 on this point. That case is *John Blue Co.* v. *Dempster Mill Mfg. Co.* (D. C., D. Neb.—1958), 172 F. Supp. 23, 29, 30, 31 (affirmed, 275 F. 2d 668). The facts of that case have a surprising similarity to the facts of the present case. In that case, the general manager also arbitrarily changed the named inventors on the application for the patent. The court held that the patent was invalid, and could not be corrected under Section 256.

The decision of the Court of Appeals in the present case is clearly contrary to the law and to the Congressional intent. Also, it is contrary to the decision in *John Blue Co.*

v. *Dempster Mill Mfg. Co.* (D. C. D. Neb.,—1958), 172 F. Supp. 23 (affirmed by the Court of Appeals for the Eighth Circuit, 275 F. 2d 668). This Court has not ruled on this important public federal question relating to the validity of patents under the 1952 Patent Act, and in the interest of the orderly administration of justice, the decision of the Court of Appeals in this case should not be permitted to stand to thus confuse the interpretation of the 1952 Patent Act. An authoritative ruling on the question by this Court is plainly in the public interest.

CONCLUSION.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted.

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Appendix

APPENDIX A.

(Portions of U. S. Code.)

15 U. S. C. 2—Monopolizing trade a misdemeanor or—Penalty.

"Every person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a misdemeanor, and, on conviction thereof, shall be punished by fine not exceeding fifty thousand dollars, or by imprisonment not exceeding one year, or by both said punishments, in the discretion of the court."

35 U. S. C. 102—Conditions for patentability; novelty and loss of right to patent.

"A person shall be entitled to a patent unless—"

* * * * *

"(f) he did not himself invent the subject matter sought to be patented, or"

35 U. S. C. 111—Application for patent.

"Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law."

35 U. S. C. 115—Oath of applicant.

"The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or

improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him."

35 U. S. C. 116—Joint inventors.

"When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

"If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

"Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly under such terms as he prescribes."

35 U. S. C. 256—Misjoinder of inventor.

"Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

"Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

"The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly."

35 U. S. C. 271 Infringement of patent.

"(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention within the United States during the term of the patent therefor, infringes the patent.

"(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

"(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suit-

able for substantial non-infringing use, shall be liable as a contributory infringer.

"(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement."

APPENDIX B.

IN THE UNITED STATES COURT OF APPEALS

For the Seventh Circuit.

SEPTEMBER TERM, 1961—JANUARY SESSION, 1962.

No. 13310

Zegers, Inc.,
Plaintiff-Appellee,
vs.
Edward A. Zegers, d b/a Precision Weatherstrip Co.,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

February 27, 1962.

Before KNOCH, CASTLE and KILEY, *Circuit Judges.*

KNOCH, *Circuit Judge.* Plaintiff-appellee, Zegers, Inc., brought action in the United States District Court against defendant-appellant, Edward A. Zegers, doing business as Precision Weatherstrip Co., for infringement of its United States Letters Patent No. 2,869,184.

Defendant, Edward Zegers, is a brother of Henry Zegers (who was the principal owner of Zegers, Inc., until his death shortly before the trial in the District Court) and of Raymond Zegers, manufacturer's representative for Zegers, Inc., since May, 1953, and before that, manager of

its installation department. Edward Zegers, formerly sales manager of Zegers, Inc., left it in 1955 when he organized Precision Weatherstrip Co., and entered into competition with plaintiff.

The District Judge found Claims Nos. 1, 2, 3, 4, 5 and 7 of the patent in suit to be valid and infringed, decreed injunction, and referred the matter to a master to ascertain the damages sustained by plaintiff. This appeal followed.

The patent in suit is entitled "Clip for Combination Weatherstrip and Sash Balance." The subject matter relates to a combination sash balance and weatherstrip unit with clips to releasably secure sash balance and weatherstrip units in place in a window frame unit. The clip is a flat piece of metal, with hook ends. Four clips, attached to a window frame or jamb, one each at top and bottom on each side, hold a conventional combination sash balance and weatherstrip unit removably in place. The combination unit, with its extending side edges, is flexed about its longitudinal axis to reduce the overall width of the unit to permit it to be placed flat against the frame behind the hook portions of the clip, or to be removed from them by similar flexing. The clips may be nailed or stapled in place.

The District Judge found that it has become the general custom of millwork companies to deliver window units, complete with weatherstripping, to a job site. Prior to the invention of the patent in suit, these units were nailed into place. Thus there was no convenient way to remove the unit during painting, plastering or reglazing operations. Paint, plaster or varnish falling on the metal weatherstrip hindered its operation. When the units were nailed into place, removal required the use of tools and frequently damaged the light gauge metal unit. These

problems, in existence for many years, have been solved by the invention of the devices disclosed by the patent in suit, a large number of which have been sold.

After plaintiff's introduction of its commercial embodiment of the patent in suit, in March, 1957, defendant Edward Zegers began sale of a substantially identical clip. Later he made and sold an alternative which functions in the same manner. The District Judge found that both infringed the claims listed above.

Defendant Edward Zegers contends that the patent in suit is invalid and not infringed; that removable clipping of weather-stripping in position of use in a window frame is taught by the prior art. He also asserts that the patent in suit is invalid because the patent application was filed and permitted to issue in the name of plaintiff's assignor, William H. Zegers, as sole inventor, rather than in the names of William H. Zegers and Raymond V. Zegers as joint inventors. Defendant also argues that plaintiff has come into court with unclean hands having misused its patent. It is also defendant's position that the District Court erred in denying defendant's motion for a partial new trial, after remand by this Court subsequent to the filing of this appeal.

Defendant introduced a number of patents at the trial which, defendant contends, established anticipation or lack of invention. Some of these were not before the Patent Office when the patent in suit was issued. Many of these patents describe clips from nonrelated arts, such as those used for pots and pans. Others show that combination sash balance and weather-strip units existed independently in the art. These constituted no better prior art than the patent references which were before the Patent Office, which showed independently existing clips from nonrelated arts and independently existing combination sash balance and weather-strip units. The record shows no instance of

a patent teaching removability of sash balance weather strips through flexing the combination to remove it from a hooked clip.

Two of the patents on which defendant relies are Starck Patent No. 2,307,647 and Plym Patent No. 1,959,643. Defendant asserts that Starck and Plym disclose a window structure embodying all of the elements of the patent in suit. Starck shows a channel fixed to a window jamb, which holds a spring and weatherstrip member. The latter can be removed, leaving in place the channel which extends the full length of the sash. Plym relates to removable window units for an automobile, with a retaining channel secured in the door frame, which remains in place when the window is removed. The patent itself calls for the use of a screw driver, or similar instrument to be inserted to pry the members apart.

These are not unlike the nailed-in-place units of the prior art. Defendant sees a similarity in the teaching of these two patents to the patent in suit because in the patent in suit, the clip remains in place. Defendant overlooks the fact that when the window is removed in the Starck and Plym devices, one still has the problem of keeping the fixed channel free of paint and plaster to ensure operation of the unit when the window is replaced.

A third patent on which defendant places great reliance is Conlon Patent No. 2,219,382, which does disclose a clip for securing weatherstripping to an automobile door, but once the Conlon clip is in place, the weatherstripping cannot be readily removed.

At the trial, defendant's expert witness designated Adams Patent No. 2,303,418 as the best reference. There, too, weatherstripping having a double flange for insertion in a saw slot in wood, can be removed from the slots only with substantial difficulty.

The fact that clips existed independently in nonrelated arts for many years supports the conclusion that the combination of the clip with hook ends and a combination sash balance and weatherstrip unit was not an obvious combination.

Study of the record before us indicates that the District Judge determined the status of the prior art at the time of the invention, the improvement made by the patentee, the problems existing in the industry, and their solution by the invention. The evidence fully supports his findings, and there is no basis for a conclusion that proper standards of invention were not applied. *Armour & Co.* v. *Wilson & Co.*, 7 Cir., 1960, 274 F. 2d 143, 150 *et seq.*; *Binks Mfg. Co.* v. *Ransburg*, 7 Cir., 1960, 281 F. 2d 252, 254-5.

In *Weller Mfg. Co.* v. *Wen Products, Inc.*, 7 Cir., 1956, 231 F. 2d 795, this Court said:

> "* * * a novel combination of old elements which so cooperate with each other * * * to produce a new and useful result or a substantial increase in efficiency, is patentable." [231 F. 2d 798 and other cases there cited.]

See also *McKee Door Co.* v. *Forest Door Co.*, 7 Cir., 1960, 284 F. 2d 869, and *Minneapolis-Honeywell Regulator Co.* v. *Midwestern Instruments, Inc.*, 7 Cir., #13251, Nov. 29, 1961, F. 2d . A problem existed in the industry for years. It was not solved prior to the invention disclosed by the patent in suit.

Defendant asserts here that the judgment of infringement improperly includes items which are staple articles of commerce capable of substantial non-infringing use, *i.e.*, combination sash balance and weatherstrip units. The judgment reads:

> "3. That Defendant has infringed Claims 1, 2, 3, 4, 5 and 7 by the sale of its Seal Eaz and Aleote com-

bination sash balance and weatherstrip units *with jamb clips* of its first and second forms (Plaintiff's Exhibits 23 and 24).

"4. That a perpetual injunction issue restraining Defendant from the further sale of *clips* of the kind exemplified by Plaintiff's Exhibits 23 and 24 *for use with combination sash balance and weatherstrip units*, and from otherwise engaging in any activities in infringement of United States Letters Patent No. 2,869,184." [Emphasis added.]

We cannot agree that defendant has been enjoined against selling sash balance and weatherstrip units without clips. Defendant states that 82% to 84% of his weatherstrip units are sold without clips.

The testimony indicates that application for the patent in suit was initially prepared in the name of Raymond Zegers; that after consideration of the facts in the light of advice of patent counsel, it was determined that Raymond Zegers had urged the need for ready removability and had suggested one method which involved use of nails, but which had proved unsuccessful; that William H. Zegers had independently conceived the device shown in the patent application. Raymond Zegers himself was one of the witnesses who testified to that effect at the trial. Application was therefore made in William H. Zegers' name. The evidence supported the Trial Judge's finding that William H. Zegers was the actual inventor. There was no showing of a joint invention.

The District Judge found that defendant failed to establish any evidence that plaintiff violated the anti-trust laws or otherwise misused its patent. Defendant's counterclaim was accordingly dismissed. Defendant relied principally on a letter sent by plaintiff to defendant which charged that defendant was infringing plaintiff's patent by sales of his "weatherstrip [illegible] Seal-Eaz" and his "modified

weatherstrip * * Alcote." Defendant's own letters and accompanying literature describing the accused devices show that his "Seal-Eaz" and "Alcote" were being promoted for sale with clips.

Shortly after this appeal was docketed with this Court, defendant's petition was granted to remand the cause to the District Court to allow defendant to file a motion for a new trial on the basis of newly discovered evidence. This evidence concerned sales and shipments by plaintiff of combination weatherstrip and sash balance units and other window equipment, without clips, in containers marked with notice of the patent in suit. After hearing argument, the District Judge denied defendant's motion for a partial new trial.

Defendant asserts that the basis for remand to secure hearing on newly discovered evidence is (1) due diligence in efforts to secure such evidence, and (2) the convincing quality of the newly discovered evidence. *Chicago and W.I.R. Co.* v. *Chicago & E. R. Co.*, 7 Cir., 1944, 140 F. 2d 130, 131-2. Defendant therefore concludes that this Court by remanding the cause must have considered that a new trial was justified. Plaintiff did not contest defendant's diligence. The District Court scheduled a hearing on defendant's motion. After consideration of the affidavits, briefs, and argument, the District Judge found that the plaintiff had shipped some of its products which were not covered by the patent in suit, in cartons bearing the patent number. He determined that this was the result of error in selection of cartons in plaintiff's shipping department; that, on notification of the errors, plaintiff took immediate steps to ensure that the patent number was removed from all cartons leaving its factory; and that no intent to deceive or resulting damage was shown. Under these circumstances we cannot rule that denial of defendant's motion for partial new trial constituted an abuse of

the District Court's discretion. This Court remanded the cause to the District Court solely for the purpose of granting the defendant leave to file a motion for a new trial. This Court did not order a new trial.

We have carefully considered all other points and authorities raised by defendant, but have found them lacking in merit. The judgment of the District Court is affirmed.

A true Copy:
Teste:

APPENDIX C.

IN THE UNITED STATES DISTRICT COURT,

Northern District of Illinois,

Eastern Division.

Zegers, Inc., *Plaintiff.* vs. Edward A. Zegers, d b a Precision Weatherstrip Co., *Defendant.*	Civil Action No. 59 C 1234.

ORDER.

This cause having come on to be heard upon Defendant's Motion for a New Trial and the Court having given consideration to the Order dated June 7, 1961, entered by the United States Court of Appeals for the Seventh Circuit, in Appeal No. 13,310, the motion by Defendant for a new trial based upon newly discovered evidence and the Affidavits of Daniel V. O'Keeffe, Edward A. Zegers, George Gillespe and Howard Dekker in support of such motion; the Affidavits of Howard Dekker and Thomas P. Koebel filed in Opposition to the Motion for a New Trial; briefs filed by both parties relative to the Motion for a New Trial, and oral arguments supplemental thereto, and the Court finding:

a. That the substance of Defendant's allegation is that Plaintiff has shipped some of its products not covered by Patent No. 2,869,184 in cartons bearing this

patent number which practice Defendant alleges constitutes a misuse of the patent and a violation of the anti-trust laws;

b. That the substance of Plaintiff's response to the motion is that to the extent that such products not covered by Patent No. 2,869,184 were shipped in cartons bearing such patent number, such practice resulted from errors occurring in Plaintiff's shipping department wherein cartons bearing the patent number were inadvertently selected for packaging products not covered by the patent;

c. That promptly upon being notified of such errors in Plaintiff's shipping department, Plaintiff took steps to insure that Patent No. 2,869,184 was removed from all cartons leaving Plaintiff's factory;

d. That Defendant has not suggested any evidence to establish that the inclusion of Plaintiff's patent number on cartons not containing products covered by the patent was intended to deceive the public or to achieve a monopoly on unpatented combination sash balance and weatherstrip units or any non-patented products made by Plaintiff, and there is no evidence that the public was actually deceived or affected in any way by Plaintiff's inadvertent incorrect use of its patent number;

IT IS HEREBY ORDERED:

1. That Defendant's Motion for a New Trial be, and the same is hereby denied.

2. That the Clerk certify to the United States Court of Appeals for the Seventh Circuit Defendant's Motion for a New Trial, the Affidavits filed by both parties pertaining to such Motion, and this Order.

3. That this case be, and the same is hereby returned to the jurisdiction of the United States Court of Appeals for the Seventh Circuit Court.

M. L. IGOE,
United States District Judge.

August 25, 1961.
Date.